

## **REMARKS**

Initially, applicant would like to thank the examiner for the courtesy of the telephone interview conducted on June 4, 2004. During the interview the examiner and applicant's representative discussed the restriction requirement presented in the Office Action. Applicant's representative provisionally elected claims 1-30 for examination.

Paragraph 1 of the Office Action detailed the earlier restriction requirement and requested affirmation of the prior provisional election to the restriction requirement. Accordingly, applicant affirms the election without traverse of group I, consisting of claims 1-30. Claims 31-34 have been withdrawn.

### **A. Background**

Claims 1-34 were pending in the application at the time of the Office Action. The Office Action objected to the specification and drawings on formal grounds. Claims 1-30 were rejected as being indefinite, and claims 16-23 were rejected because they were directed to non-statutory subject matter. Claims 1-4, 9-13, 16-19, 24, 25, 27, and 28 also were rejected as being anticipated over cited prior art, and claims 5-8, 14, 15, 20-23, 26, 29, and 30 were rejected as being obvious over cited prior art. By this response applicant has amended the specification and drawings to overcome the formal issues. Applicant also has amended claims 1, 4, 15-24, and 28, and added new claims 35-36. As such, claims 1-30 and 35-36 are presented for the Examiner's consideration in light of the following remarks.

B. Amendments

1. Amendments to the Specification

Paragraph 2 of the Office Action objected to the specification based on various informalities. Specifically, the Office Action stated that the title of the invention "is not descriptive" and suggested a title that would be descriptive. Applicant has amended the title to adopt the Examiner's suggested title. The Office Action also objected to the specification based on various typographical errors. Applicant has amended the paragraph that begins on page 3, line 26, of the specification to overcome this objection. Other typographical errors as indicated above also have been corrected. Applicant submits that amendments to the specification do not introduce new matter and entry thereof is respectfully requested.

2. Proposed Amendments to the Drawings

Paragraph 3 of the Office Action rejected Figures 1, 2, and 4 because they include "numbered objects that do not include adequate labels or legends." Applicant has amended Figures 1, 2, and 4 to include descriptive text labels corresponding to elements 140, 150, 160, and 190 in Figure 1; elements 1-9 in Figure 2; and elements S1-S14 in Figure 4, as supported in the application text as originally filed. Accordingly, applicant respectfully submits that the amendments to the drawings do not introduce new matter and entry thereof is respectfully requested. As indicated above, see, for example, the paragraphs beginning on page 13 at line 31 and beginning on page 15 at line 3, as well as the description of Figure 4, which begins on page 19 at line 13, for support.

3. Amendments to the Claims

By this response applicant has amended claims 1, 4, 15-24, and 28. These claims have been amended to address formal matters and are supported by the application as originally filed. In view of the foregoing, applicant respectfully submits that the amendments to the claims do not introduce new matter and entry thereof is respectfully requested.

C. Rejection on the Merits

Paragraph 4 of the Office Action rejected claims 1-30 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action gives three reasons for the rejection. First, the Office Action states that the phrase "such as" renders independent claims 1 and 16 and all corresponding dependent claims 2-15 and 17-23 indefinite. Applicant has amended claims 1 and 16 to remove the phrase "such as" to overcome the rejection. Second, the Office Action states that the phrase "said network server" in line 5 of independent claim 24 lacks antecedent basis. Applicant has amended claim 24 to recite "a network server" to overcome this rejection. Third, the Office Action states that the term "arrangement" in the preamble of claims 16-23 is ambiguous. Applicant has replaced the term "arrangement" with the term "system" in amended claims 16-23 to overcome the rejection. Accordingly, applicant respectfully submits that the rejection of claims 1-30 under 35 U.S.C. § 112, second paragraph, as being indefinite should be withdrawn.

Paragraph 5 of the Office Action rejected claims 16-23 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Office Action states that "it is not clear whether the 'arrangement' claimed is a process, machine, manufacture, or composition of matter, or

whether the 'arrangement' is something else, such as a pure computer algorithm or an algorithm."

As mentioned above, applicant has replaced the term "arrangement" with the term "system" in amended claims 16-23 to overcome the rejection. Accordingly, applicant respectfully submits that the rejection of claims 16-23 under 35 U.S.C. § 101 as being directed to non-statutory subject matter should be withdrawn.

Paragraph 6 of the Office Action rejected claims 1-4, 9-13, 16-19, 24, 25, 27, and 28 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,205,330 to Winbladh ("*Winbladh*"). Of these, claims 1, 16, and 24 are independent claims. Paragraph 7 of the Office Action rejected claims 5-8, 14, 15, 20-23, 26, 29, and 30 under 35 U.S.C. § 103(a) as being unpatentable over *Winbladh* in view of U.S. Patent No. 6,636,502 to Lager et al. ("*Lager*").<sup>1</sup>

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131. That is, "for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly." MPEP § 706.02. Applicants also note that "[i]n determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure.'" MPEP § 2121.01. In other words, a cited reference must be enabled with respect to each claim limitation. During examination, the pending claims are given their broadest reasonable interpretation, *i.e.*, they are interpreted as broadly as their terms reasonably allow, consistent with the specification. MPEP §§ 2111 & 2111.01.

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<sup>1</sup>Although the prior art status of the cited art is not being challenged at this time, Applicants reserve the right to do so in the future. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status or asserted teachings of the cited art.

*Winbaladh* discloses that when an email arrives, host arrangement 11 creates an SMS (short message service) message and sends the SMS message to an MS (mobile station) unit (e.g., one with a display that is only able to accommodate a limited number of characters at a time). Col. 1, ll. 20-29; col. 7, ll. 6-8. The SMS message includes an application prefix (e.g., email), an email notification 45, and an agent part that includes a "Job\_id" field corresponding to the email stored on the server 11, a "Code" field with a password for downloading the "Job\_id" email, and a "DSG address (Data SMS Gateway Address)" field containing the address and/or telephone number of the server 11 where the email is stored. Col. 7, ll. 8-35. The SMS message is stored in the MS unit (often a cellular telephone), where communication software 46 in a computer 22 can read the notification information 45. Col. 7, ll. 36-42 and Figure 2.

By connecting the MS unit to a computer 22, with the communication software 46, the SMS messages stored in the MS unit (20) may be read and transferred to the appropriate application software 49 in computer 22. Col. 7, ll. 38-42. Computer 22 displays notification information and specific commands, such as "Get Now," "Get Later," and "Delete Mail." Then, when the "Get Now" function is activated, for example, the communications software 46 reads the agent part of the SMS message and executes the following procedures: (1) calls the number in the "DSG address" 47 to start a session; (2) transfers the "Job\_id" and "Code" to the server 11, which then transmits the email; and (3) releases the transmitting part of the session when transmission is terminated. Col. 7, l. 58 – col. 8, l. 2.

From the drawings, and corresponding description, it should be apparent that the communication software 46 and application software 49 are part of the computer 22. *See, e.g.,* Figures 2 and 4-6. In other words, communication software 46 within computer 22, as opposed to within mobile station 20, uses the "DSG address" field to establish a session with server 11. *See*

also, col. 4, l. 36 – col. 6, l. 2. Yet in rejecting independent claim 1, the Office Action cites to these portions of *Winbladh* as disclosing “initiating immediate transfer of packet data from a network server (‘server 11’) to a mobile communication station (‘MS unit 20’) over a digital radio communication network” by “extracting [a] first packet data network address from [a] message by way of an application executing on the mobile communication station” and “establishing, from the application of the mobile communication station having a second packet data network address . . . a packet data protocol session with said network server using said first packet data network address.” Office Action, pp. 6-7 (rejection of claim 1). Similar assertions are made with respect to independent claims 16 and 24. Office Action, pp. 10-11 (rejection of claims 16 and 24). As discussed in detail above, however, applicant respectfully submits that the portions of *Winbladh* cited in rejecting the independent claims make no such disclosure relative to the transfer of packet data from a network server to a mobile communication station. Rather the cited portions of *Windbladh* relate to communication between a computer 22 and an MS unit 20 or to communication between a computer 22 and a server 11.

Thus, the cited portions of *Winbladh* do not teach, suggest, or enable a method for initiating immediate transfer of packet data from a network server to a mobile communication station over a digital radio communication network, which includes

**establishing**, from the application of the mobile communication station having a second packet data network address, **a packet data protocol session with said network server** using said first packet data network address,

**whereby the network server is able to transfer packet data to the mobile communication station and the application using said packet data protocol session,**

as recited in claim 1, or a system at a mobile communication station for facilitating immediate transfer of packet data from a network server to a mobile communication station over a digital

radio communication network, which includes "**packet data protocol means for establishing a packet data protocol session with said network server**," as recited in claim 16, or a program storage device containing instructions

**causing the mobile communication station**, to which a second packet data network address is allocated, **to establish a packet data protocol session with said network server** using said first packet data network address; and

**causing the mobile communication station to receive packet data**, addressed to the second packet data network address, from **the network server via said packet data protocol session**,

as recited in claim 24.

Claims 2-15 and 35 depend from claim 1; claims 17-23 and 36 depend from claim 16; and claims 25-30 depend from claim 24. These dependent claims incorporate the limitations of their corresponding independent claims. As such, applicant submits that claims 2-15 and 35, 17-23 and 36, and 25-30 are distinguished over the cited art for at least the same reasons as discussed above with regard to claims 1, 16, and 24.

#### D. Conclusion

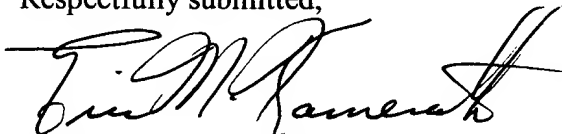
Applicant notes that this response does not discuss every reason why the claims of the present application are distinguished over the cited prior art. Most notably, applicant submits that many if not all of the dependent claims are independently distinguishable over the cited prior art. Applicant has merely submitted those arguments which it considers sufficient to clearly distinguish the claims over the cited prior art.

In view of the foregoing, applicant respectfully requests the Examiner's reconsideration and allowance of claims 1-30 and 35-36 as amended and presented herein.

In the event there remains any impediment to allowance of the claims which could be clarified in a telephone interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

Dated this 5<sup>th</sup> day of January 2005.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Eric M. Kamerath", with a stylized flourish at the end.

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### AMENDMENTS TO THE DRAWING

Attached are three sheets of formal Replacement Drawings. Sheet 1 contains Figure 1 which includes changes to Figure 1. This replacement sheet replaces the corresponding originally filed sheet including Fig. 1. In Figure 1, previously omitted descriptive text labels for elements 140, 150, 160, and 190 have been added. Support for these descriptive text labels may be found within the paragraph beginning on page 13 at line 31 and within the paragraph beginning on page 15 at line 3.

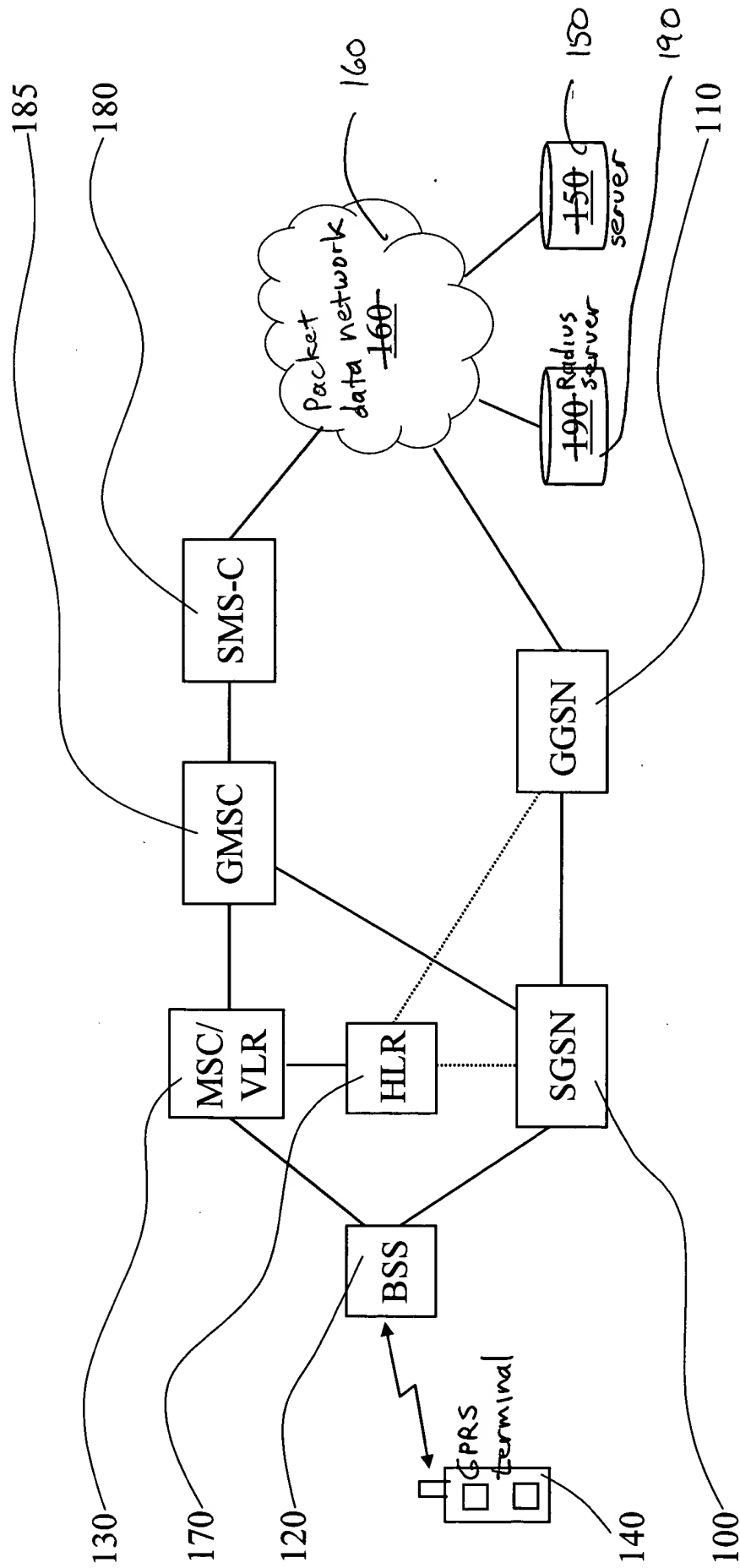
Sheet 2 contains Figure 2 which includes changes to Figure 2. This replacement sheet replaces the corresponding originally filed sheet including Fig. 2. In Figure 2, the previously omitted text "step" for each of the numbered processing elements 1-9 has been added.

Sheet 4 contains Figure 4 which includes changes to Figure 4. This replacement sheet replaces the corresponding originally filed sheet including Fig. 4. In Figure 4, previously omitted descriptive text labels for elements S1-S14 have been added. Support for these descriptive text labels may be found in connection with the description of Figure 4, which begins on page 19 at line 13.

Attachment: 3 Replacement Sheets

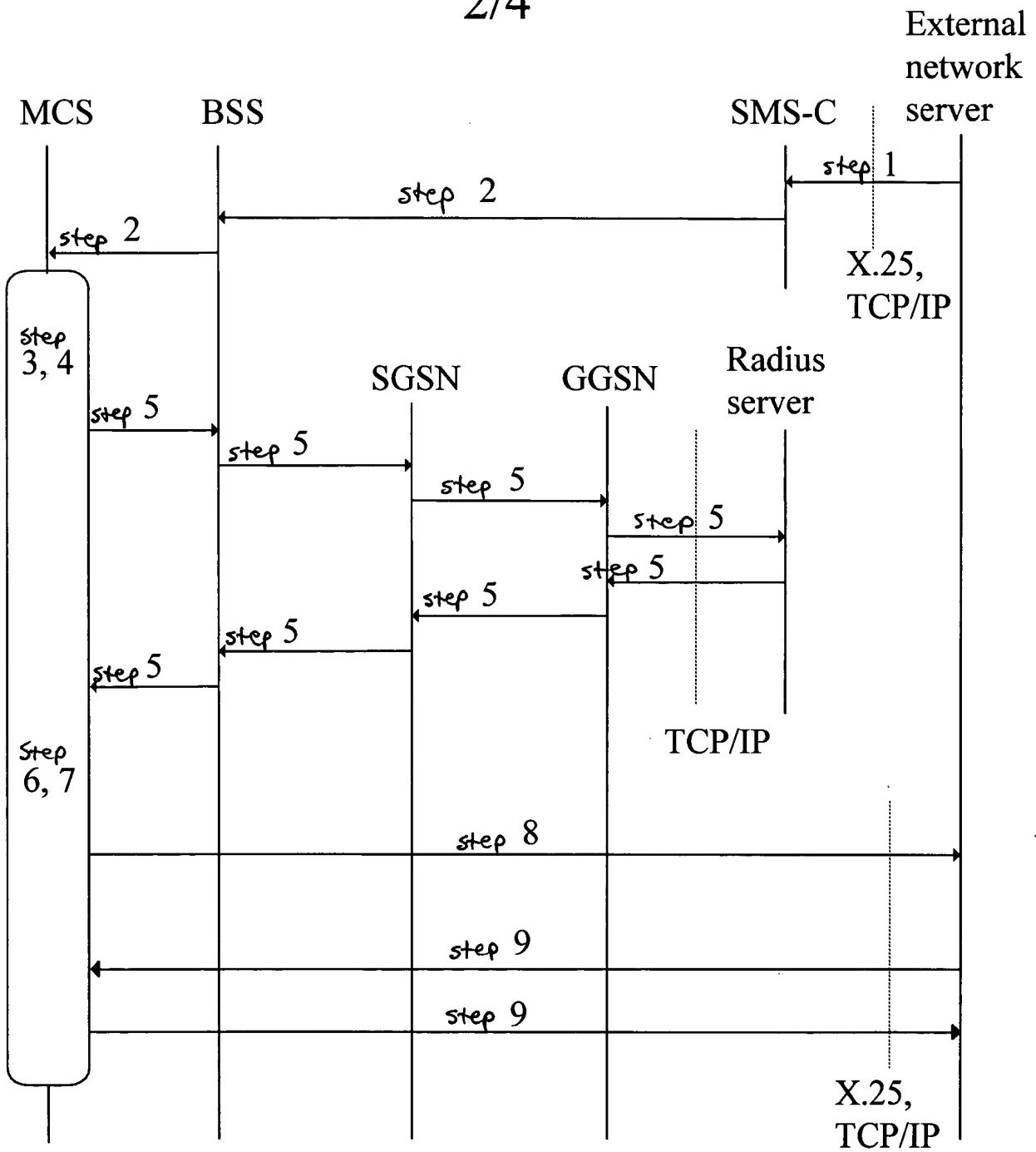
3 Annotated Sheets Showing Changes

1/4



**FIG. 1**

2/4



**FIG. 2**

4/4

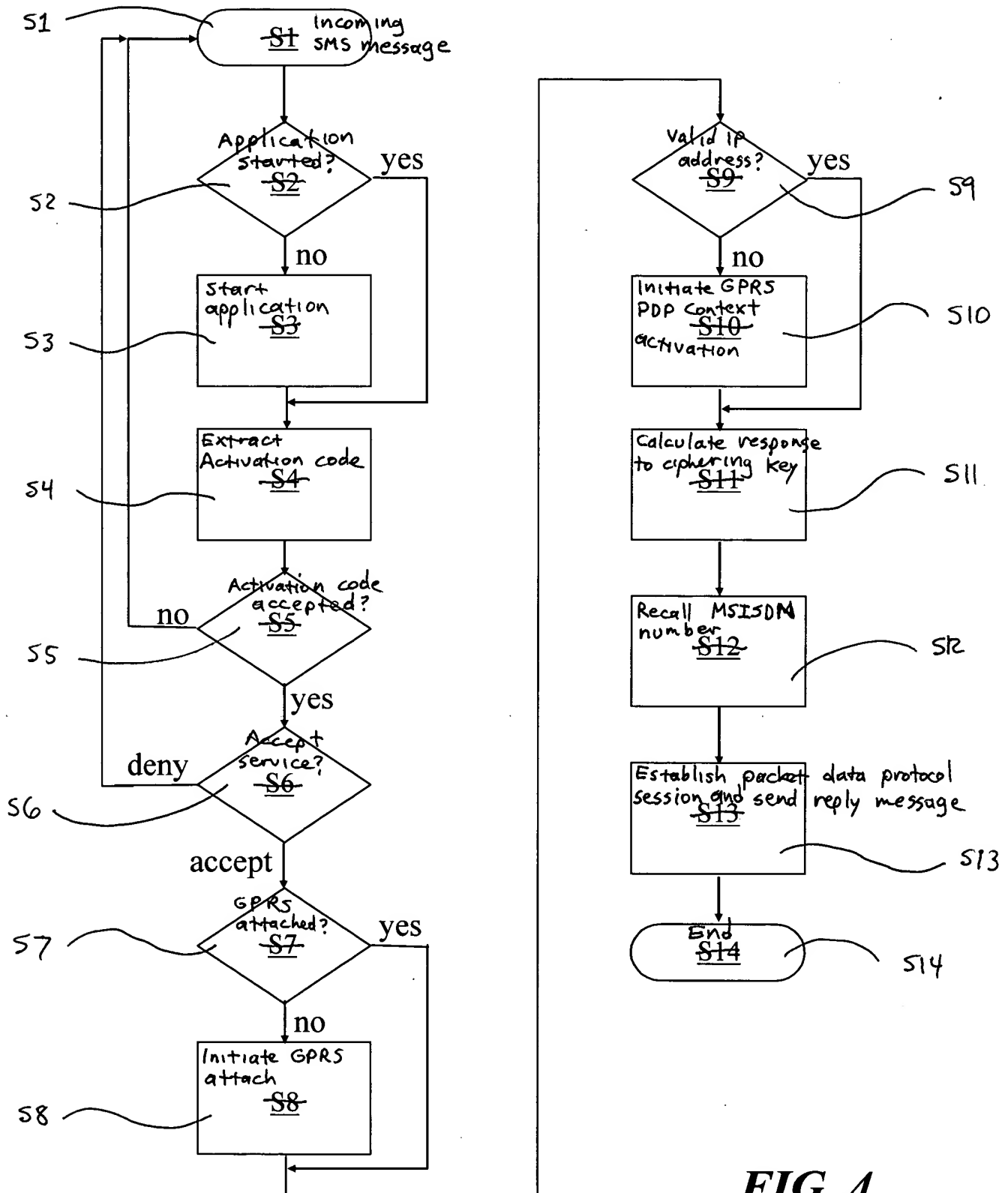


FIG. 4